

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

M. CHAMBERS 3-2

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 2, 2006

Signature Debbie SamsTyped or printed name Debbie Sams

Application Number

10/695,603

Filed

October 28, 2003

First Named Inventor

Michael J. Chambers

Art Unit

2617

Examiner

Jaime M. Holliday

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
 (Form PTO/SB/98)

☒

attorney or agent of record.

Registration number 48,981☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

J. Joel Justiss  
 Signature  
 J. Joel Justiss

Typed or printed name

972-480-8800

Telephone number

November 2, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael J. Chambers, et al.  
Serial No.: 10/695,603  
Filed: October 28, 2003  
Title: SYSTEM AND METHOD EMPLOYING A MOBILE TELEPHONE TO  
RETRIEVE INFORMATION REGARDING AN ARTICLE  
Grp./A.U.: 2617  
Examiner: Jaime M. Holliday Confirmation No.: 6324

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

|                                                                                                                               |        |
|-------------------------------------------------------------------------------------------------------------------------------|--------|
| I hereby certify that this correspondence is being electronically filed<br>with United States Patent and trademark Office on: |        |
| November 2, 2006                                                                                                              | (Date) |
| Debbie Sams                                                                                                                   |        |
| (Printed or typed name of person signing the certificate)                                                                     |        |
| /Debbie Sams/                                                                                                                 |        |
| (Signature of the person signing the certificate)                                                                             |        |

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The Applicants have carefully considered this application in connection with the Examiner's Final Rejection mailed August 1, 2006, and the Advisory Action mailed October 19, 2006. The Applicants respectfully request a pre-appeal brief review of this application in view of the following remarks.

### REMARKS/ARGUMENTS

The Applicants originally submitted Claims 1-21 in the application. The Applicants amended Claims 1, 3, 7, 11, 18 and 21 in a previous response. The Applicants have not canceled or added any claims. Accordingly, Claims 1-21 are currently pending in the application.

#### **I. Rejection of Claims 1-6, 8, 11, 12, 14-18 and 21 under 35 U.S.C. §103**

The Examiner has rejected Claims 1-6, 8, 11, 12, 14-18 and 21 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Simon (U.S. Patent No. 6,974,078). The Applicants respectfully disagree since the cited combination of Ogasawara and Simon does not teach or suggest each element of independent Claims 1, 11 and 21. More specifically, the cited combination does not teach or suggest supplying information about an article from multiple distributors of the article **based on interpreting an image**, of at least a portion of an article recorded by a camera associated with a mobile telephone, to identify the article.

The Examiner recognizes that Ogasawara does not address searching more than one database from two different distributors and cites Simon to cure this deficiency. (*See Examiner's Final Rejection*, page 4.) Simon discloses an information retrieval and communication system 1 that includes a personal communication device 10 in communication with a communications server 30 over communication link 20. (*See column 2, lines 48-53, and Figure 1.*) Server 30 is communicably coupled to one or more databases 32 over one or more network connections. (*See column 3, lines 11-12.*)

The information retrieval and communication system 1 of Simon, however, does not supply information about the product to the personal communication device 10 from the various databases **based on interpreting an image** of the product. Instead, Simon searches various databases over the Internet for desired product-related information **in response to a search inquiry from a user**. (*See column 1, lines 61-64; column 2, lines 13-21; column 3, lines 37-46.*) Thus, instead of supplying information about the product from the multiple databases to the personal communication device 10 based on interpreting an

image to identify the product, Simon requires a search inquiry before obtaining information about the product from the multiple databases. After the search inquiry, the information is then supplied to the personal communication device 10. Simon, therefore, does not search for information of an interpreted image based on interpreting the image but requires a search inquiry. As such, Simon does not teach or suggest interpreting an image to identify an article and, **based thereon**, supplying information about the article from multiple databases to the mobile telephone as recited in independent Claims 1 and 11.

In the Advisory Action, the Examiner argued that Simon discloses a "product identifier is first searched by the server and then the information is searched in the databases." The Examiner relied on column 1, lines 56-61, of Simon that reads as follows:

The communication device established a communication link with a communication server, and the product information is transmitted to the server, which interfaces with one or more product information libraries to determine a product identifier based on the input product information.

Thus, Simon teaches the communication server can interface with multiple product information libraries to determine the product identifier. However, once the product is identified (*i.e.*, the product identifier is determined), Simon teaches that a search query from a user is needed before product-related information is provided. This is clearly evident from column 1, lines 61-64, of Simon as stated below:

The product identifier is used by the server to search various databases over the Internet for desired product-related information in response to a search query from the user.

Thus, Simon may teach accessing multiple libraries to identify a product, but Simon neither teaches nor suggests supplying information about the product from multiple databases based on interpreting an image of the product. Simon, therefore, does not cure the above noted deficiency of Ogasawara.

To establish a *prima facie* case of obviousness, three basic criteria must be met including the references when combined must teach or suggest all the claim limitations. As noted above, Ogasawara

and Simon, individually or in combination, fail to teach or suggest each element of independent Claims 1 and 11 Claims dependent thereon. Accordingly, the cited combination also fails to teach or suggest software that interprets an image to identify an article and queues data based on the interpreting for transmission to a mobile telephone as recited in independent Claim 21. As such, the cited combination does not provide a *prima facie* case of obviousness of Claims 1-6, 8, 11, 12, 14-18 and 21. Thus, Claims 1-6, 8, 11, 12, 14-18 and 21 are not obvious in view of the cited combination and the Applicants respectfully request the Review Panel to remove the §103(a) rejection of Claims 1-6, 8, 11, 12, 14-18 and 21 allow issuance thereof.

The combination of Simon with Ogasawara is also improper since there is no suggestion or motivation to combine Simon with Ogasawara. Ogasawara is directed to an electronic shopping system that is not for obtaining information about a product from various databases over a network but instead is for facilitating purchases of a product from the store that provides the electronic shopping system to the videophone. (See column 3, lines 4-20; lines 21-42 and Figure 1.) In Ogasawara, employing the videophone allows retailers to implement a personal shopping system for their store while minimizing the investment cost. (See column 3, lines 17-20; column 3, line 67 to column 4, line 2; and Figure 1.)

On the other hand, Simon is directed to scanning information from a product, providing a search inquiry and, based thereon, searching various databases for related product information. (See column 1, lines 45-64.) Simon, therefore, frustrates the invention of Ogasawara since Simon promotes obtaining competitive pricing from other stores while shopping for a product in a first store. (See column 3, lines 47-49.) Thus, Simon teaches away from facilitating product purchases from a particular store as in Ogasawara. (See, MPEP 2143.01.) As such, the cited combination is improper since one skilled in the art would not be motivated to combine Simon with Ogasawara.

**II. Rejection of Claims 7, 9-10, 13 and 19-20 under 35 U.S.C. §103**

As argued in the previous response, the cited combination of Marggraff, Lev, Swartz or Rehbein with Ogasawara and Simon does not provide a *prima facie* case of obviousness of independent Claims 1 and 11 and Claims dependent thereon. Accordingly, the Applicants respectfully request the Review Panel to remove the §103(a) rejections with respect to Claims 7, 9-10, 13 and 19-20 and allow issuance thereof.

**III. Conclusion**

In view of the foregoing remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-21.

The Applicants request the Reviewers to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read "J. Joel Justiss", written in a cursive style.

J. Joel Justiss  
Registration No. 48,981

Dated: November 2, 2006

P.O. Box 832570  
Richardson, Texas 75083  
(972) 480-8800